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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,838	01/04/2001	Kazunori Kondo	53859USA2A.0	2568
32692	7590	05/26/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			CHANNAVAJJALA, LAKSHMI SARADA	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/582,838	<b>Applicant(s)</b> KONDO ET AL.	
	<b>Examiner</b> Lakshmi S Channavajjala	<b>Art Unit</b> 1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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### DETAILED ACTION

Receipt of Information disclosure statements dated 3-2-01, 5-3-01, 8-20-01, 3-27-02 and 9-26-02 is acknowledged.

Claims 9-16 are pending. Instant claims 1-8 are directed to an oil cleaning sheet for makeup, comprising a porous stretched film of a plastic material having a void size of 0.2 to 5 microns.

Claims 9-16 are directed a method of removing facial oil comprising oil cleaning sheets as described in claim 1.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,822,350 to Ito et al (Ito).

Ito discloses an absorbent article comprising a microporous, leak proof, stretched polymeric film sheet having pore size of 0.05 to 5 microns, a film thickness of not more than 60 microns, a pore volume 0.1 cm<sup>3</sup> to 1.0 cm<sup>3</sup> (col. 1, lines 45-65). The polymeric film of Ito has the same pore sizes and thickness in the same range as that claimed in the instant claims. Therefore, the claimed interstitial volume, which is function of film thickness and void content, is inherent to the polymer sheet of Ito. With respect to the claimed 'oil cleaning', the claim is directed to a composition and the preamble does not carry patentable weight. Claim 4 recites a hydrophilic liquid absorbing substance on the surface of the sheet. Ito discloses several filler

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materials to be included on the film, all of which read on the claimed substance. Thus, Ito anticipates instant claims.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by KOKAI PATENT HEI 10-15304 (HEI).

HEI discloses a fat or oily substance absorber comprising a polyolefin in the form of a film, strip or sheet. The sheet of HEI is porous having a pore diameter of 0.001 to 1micron (0001 & 0010). HEI further discloses the film thickness to be 5 to 50 microns (0021). HEI does not specifically disclose the claimed interstitial volume and the void content. However, the pore diameter disclosed by HEI is in the same range as that claimed and accordingly, the claimed void content and hence the interstitial volumes are inherent to the porous sheet or film of HEI.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1066826 (EP) in view of KOKAI PATENT HEI 10-15304 (HEI) or HEI in combination with EP.

EP teaches personal cleaning sheet for cleaning oil from skin and hair comprising a structure having an oil absorbing layer laminated with an aqueous liquid retention layer to retain

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aqueous cleansing liquid. The oil absorption layer is made of a thermoplastic resin that has a porosity of 5 to 50% (page 3) and a thickness of about 20 to 300 microns (page 4, lines 33-34). Further, EP teaches the oil-absorbing layer is filled with a particulate powder to improve the oil absorbing capacity of the layer (page 3, lines 40-50). EP fails to teach the claimed interstitial volume, pore diameter and the liquid absorption capacity, as claimed.

HEI, discussed above, teaches oil absorbing stretched polymeric films having pore size and thickness of the film in the claimed range. HEI does not explicitly state the claimed properties such as the water absorption capacity, interstitial volume, and liquid absorbing substance. HEI also fail to teach use of oil absorbing sheets for the removal of facial oil. However, EP teaches that the inorganic powder having a particle size of 1 to 30 microns is preferable to fill the porous liquid absorption layer, such that the powder is contained. HEI also teaches the pore size of the oil-absorbing sheet in the claimed range. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the pore size of the oil absorption layer so as to contain the powder particles. Further, both EP and HEI are directed to oil absorbing sheets and teach the thickness, porosity of the sheets and HEI further teaches that the absorption of oil is a function of porosity and pore size (0010). Even though HEI or EP fail to teach the claimed interstitial volume (claims 2 and 10) or the claimed absorption capacity (claim 7 and 15). Accordingly, optimizing the porosity of the oil absorbing sheets with an expectation to achieve a sheet having the desired holding or absorbing capacity would have been obvious for one of an ordinary skill in the art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,533,119. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims recite a package of oil absorbing wipes comprising plurality of thermoplastic sheets, which have a average diameter of less than 10 microns, a void volume of 40-80 percent and an oil absorption capacity of 0.8 to 5 mg/square centimeter. While instant claims recite individual sheets, the patented claims recite a package of stacked sheets. Thus, the stack of oil absorbing sheets in the package of the patent are used for the same purpose i.e., cleaning oil as the individual oil absorbing sheets of the instant claims and accordingly preparing the oil absorbing sheet with the claimed parameters for the purpose of effectively cleaning oil would have been obvious for one of an ordinary skill in the art at the time of the instant invention.

Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,645,611. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the patented claims recite a package of oil absorbing wipes comprising plurality of thermoplastic sheets, which possess the same properties such as porosity, interstitial volume and oil absorbing capacity as that claimed (dependent claims of the patent). While instant claims recite individual sheets, the patented claims recite a package of stacked sheets. Thus, the stack of oil absorbing sheets in the package of the patent are used for the same purpose i.e., cleaning oil as the individual oil absorbing sheets of the instant claims and accordingly preparing the oil absorbing sheet with the claimed parameters for the purpose of effectively cleaning oil would have been obvious for one of an ordinary skill in the art at the time of the instant invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala

Examiner

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May 24, 2004